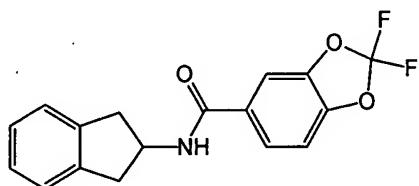


Office Action, page 2. In addition, the Examiner requires election of a single species of compounds of formula (I) under 35 U.S.C. § 121. *Id.* at page 3.

Applicants respectfully traverse the restriction and election requirements. However, to be fully responsive, Applicants provisionally elect, with traverse, the subject matter of Group I, claims 1-6, 21, and 22, for prosecution on the merits. In addition, Applicants provisionally elect, with traverse, the compound of Example 66 disclosed on page 18 of the published specification, *i.e.*, 2,2-difluoro-benzo[1,3]dioxol-5-carboxylic acid indan-2-ylamide, according to the following formula:



The Examiner indicates that “[u]pon the election of a single disclosed species . . . a generic concept, inclusive of the elected species, will be identified by the Examiner for examination.” *Id.* at page 4. The Examiner further requires Applicants to “list all claims readable thereon” for examination. *Id.* However, without knowing what “generic concept” the Examiner will identify for examination based on the Applicants’ selection, the requirement of listing all claims readable thereon, besides elected claims 1-6, 21, and 22, as originally filed, imposes an unreasonable and undue burden on Applicants. And the Examiner has failed to provide any statutory basis for such a requirement. Therefore, Applicants respectfully reserve the right to supplement a list of all claims for prosecution on the merits after the Examiner identifies the “generic concept” for examination.

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Applicants respectfully traverse the restriction and election requirements for at least the following reasons.

For a restriction requirement to be proper, the Examiner must show that a serious burden exists if all claims are examined together. M.P.E.P. § 803 (8th ed., August 2001). However, the Examiner has not shown that there would be a serious burden to examine the claims of Groups I-III together. Further, Applicants respectfully submit that examining all of the claims together would not impose a serious burden, because all claims recite a compound of formula (I).

While "a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification," among other things, *id.*, the Examiner has not shown entirely separate classification. Groups I and II are listed as falling within classes 514, 544, 546, and 548; and Group III is listed as falling within classes 544, 546, and 548. Office Action, page 2. Therefore, by examining the claims of Group I in the cited classes, the claims of Groups II and III could also be examined. Accordingly, Applicants respectfully request that the Examiner withdraw the restriction and election requirements and examine Groups I-III together.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: April 23, 2003

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